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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/726,808

12/02/2003

Luis Elenes

200309860-1

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06/28/2005

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EXAMINER

BOWER, KENNETH W

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,808

Applicant(s)

ELENES, LUIS

Examiner

Kenneth W. Bower

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-23 and 25-27 is/are rejected.
- 7) ☒ Claim(s) 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/02/2003</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 12 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Harvey (US 4,681,312).

Harvey (US 4,681,312), discloses a printing apparatus (column 1, line 8), placing colorant (inherent in a printing apparatus), upward path (3), moving means (2a, 2b, 4a and 4b), by contact of a face (rollers inherently contact faces, Fig. 1), upward and over (roller 4b), rotatable member (9a) resilient member (9c and column 4, line 50).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10, 12-23, 25 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvey (US 4,681,312) as applied to claim 27 above in view of Fukuda et al. (US 6,488,279).

Harvey (US 4,681,312) discloses sheet processing apparatus (Fig. 1), sheet medium (1), roller (4b) carrying the trailing edge up and over (column 3, lines 25-40).

Harvey (US 4,681,312) lacks rotating a roller in one direction and deflecting a resilient member in a second direction, trailing edge engaging a resilient member for 90 to 180 degrees, spacing the trailing edge using gravity, coloring sheet before hand, upward path, upward then downward carrying, roller contacting face, rotatable member, resilient member, generally opposite the direction, bending opposite, bending upon contact with sheet, thinned region with respect to size of hub, extended position and retracted position, distal portion, plurality of resilient members, integral connection, single piece, elastomeric material, planar surface and extending nonlinearly.

Fukuda et al. (US 6,488,279) discloses a rotating a roller in one direction and deflecting a resilient member in a second direction (Fig. 5), trailing edge engaging a resilient member (column 4, line 50), for 90 to 180 degrees (Fig. 1), spacing the trailing edge using gravity (Fig. 1, inherent), coloring sheet before hand (column 1, line 8), upward path (Fig. 1), upward then downward carrying (Fig. 1), roller contacting face (4a or 4b), generally opposite the direction (the face of the projections slant away from the paper direction and are considered therefore to be generally opposite the direction), bending opposite (Fig. 9c), bending upon contact with sheet (Fig. 9c, "bending upon" is interpreted to mean at the same time as which is shown, "in response to" would tie this limitation to the force of the sheet acting to cause the bending), thinned region (region is thinned with respect to size of roller hub), extended position and retracted position Fig. 9c), radius (7), distal portion (9c), plurality of resilient members (Fig. 6), integral connection (column 5, line 40), single piece of elastomeric material 9column 5, line 42),

planar surface (leading surface of 9c) and extending nonlinearly (Fig. 6, radii at base and top of projection).

It would have been obvious to one of ordinary skill to modify Harvey by Fukuda et al. "to quickly and securely discharge a sheet after ... forming an image" as recited at (column 2, lines 38-42 of Fukuda et al.)

5. Harvey modified by Fukuda et al. meets the limitations of the claimed invention except that it discloses a sheet media processing apparatus rather than the claimed sheet media processing methods. Considering the disclosure of the references the specific teachings are directed to an apparatus that moves a sheet up and over a roller to a stacker. However, a worker in the art would reasonably be expected to draw the inference of the methods required to make and use the apparatus therefrom. Therefore it would have been obvious to one of ordinary skill to draw the claimed methods from the inferred teachings of the reference to facilitate processing a sheet as suggested by Fukuda et al. at the Abstract. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342,344 (CCPA 1968)

Allowable Subject Matter

6. Claim 24 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: An apparatus for displacing a sheet of print having all of the limitations or claim 21 in combination with the resilient finger having a thinned section where the finger bends upon contact with the paper is not found nor is sufficient motivation to make the combination found in the art of record.

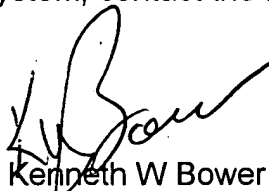
Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth W. Bower whose telephone number is (571) 272-6936. The examiner can normally be reached on 6:30AM to 3:30PM (out on alternate Fridays).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on (571) 272-6936. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kenneth W Bower
Examiner
Art Unit 3653

06/23/2005



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